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No. 98-728

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1998

DRILTECH, INC., PETITIONER,

v.

REEDRILL CORPORATION, RESPONDENT

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

REPLY TO OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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SUMMARY OF THE REPLY

This brief addresses the two principal misstatements in Reedrill's opposition brief. First, there is no procedural bar to this Court's addressing the issue of claim interpretation as part of its review of the district court's denial of Driltech's motion for judgment as a matter of law. Second, this Court has granted certiorari where, as in this

case, the Federal Circuit has affirmed a district court under Fed. Cir. R. 36.

I. Reedrill Misstates the Procedural Posture of This Case - Review of the Claim Interpretation is Under the *De Novo* Standard

Contrary to the unsupported assertions made in the opposition brief, if the Court grants the pending petition, the Court would reach the issue of claim interpretation. Moreover, interpretation of the disputed claim term is under the *de novo* standard of review.

At trial, Driltech properly and timely made a motion for judgment as a matter of law under Fed. R. Civ. P. 50(a) that no reasonable jury could find infringement of U.S. Patent No. 4,128,135 (the '135 patent). The motion was properly renewed under Fed. R. Civ. P. 50(b). In reviewing a district court's ruling on a motion for judgment as a matter of law, the Federal Circuit applies the judgment as a matter of law standard anew. *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 821 (Fed. Cir. 1992). The standard is whether a reasonable jury could have found infringement of the '135 patent. *See* Fed. R. Civ. P. 50.

To determine if a reasonable jury could have found infringement, the two-step infringement determination process must be undertaken. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998). "[T]he court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) [hereinafter *Markman I*]. The construction given the claims is reviewed

de novo. *Id.* "The second step in an infringement analysis is determining whether a particular device infringes a properly construed claim . . . ." *Wright Med. Tech., Inc. v. Osteonics Corp.*, 122 F.3d 1440, 1443 (Fed. Cir. 1997). Therefore, in reviewing the denial of Driltech's motion for judgment as a matter of law, the claim must first be properly interpreted and that interpretation applied to the accused devices.

Moreover, regardless of whether there was an objection to the jury instruction, Fed. R. Civ. P. 51 does not prevent normal appellate review in light of the motion for judgment as a matter of law. *K & T Enters., Inc. v. Zurich Ins. Co.*, 97 F.3d 171, 174-75 (6th Cir. 1996) (citing *City of St. Louis v. Praprotnik*, 485 U.S. 112, 118-20 (1988)). For both of the above reasons, if the petition is granted, the Court can and should address the question of the proper claim interpretation for the '135 patent.

In its opposition, Reedrill takes out of context several statements made by Driltech to the district court. Driltech stated at trial, as it has throughout this matter, that "the [district court] need not conduct any 'Markman' hearing *to consider extrinsic evidence*." App. Record at A01216 (emphasis added).[1]

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[1] At Appellate Record A01215-26 is the brief filed by Driltech in support of its motion in limine to preclude Reedrill's expert witness from giving the jury his claim interpretation. Driltech argued that the expert's claim interpretation amounted to impermissible extrinsic evidence of the meaning of the claim terms in dispute, *e.g.*, the disputed term "movable gate." Driltech argued that "[i]t is

(continued...)

Reedrill raises a strawman when it argues, without citation, that Driltech's proposed claim interpretation requires adding structural elements from the specification into the claim. Opposition at 9. Driltech's proposed claim interpretation adds no such elements. Reedrill confuses the requirement that claim terms be interpreted in a manner so as to comport with the claim as a whole with the admonition not to import extraneous structure from the specification into the claim. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996) [hereinafter *Markman II*]; *see also Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 950 (Fed. Cir. 1993). Claim terms may not be interpreted, as advocated by Reedrill, in a manner inconsistent with the patent document. *Markman II*, 517 U.S. at 389.

The '135 patent defines, *inter alia*, two different components. It defines a *retainer* as that component which "is operable to be moved to a position directly *above* the pipe holding arm 92 to prevent longitudinal ejection of a drill pipe section disposed in the storage rack particularly when the mast is in a reclined or substantially horizontal position." App. Record at A00085 (the '135 patent, col. 4,

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[1](...continued)
improper to rely on extrinsic evidence (such as expert testimony) when the intrinsic evidence unambiguously describes the scope of the patented invention. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996)." Appellate Rec. at A01216 (footnote omitted). Driltech explained that "[i]ntrinsic evidence includes the patent itself (both the claims and specifications), as well as the prosecution history, if in evidence." *Id.*

ll. 5-9) (emphasis added). The patent defines a *gate* as a separate component which "cooperates with an arcuate recess 100 formed on the [upper] arm to loosely retain the upper end of a drill pipe section, that is to say the gate 96 does not forcibly clamp the pipe section in the gate closed position." *Id.* at col. 3, ll. 64-68. In one place, the patent refers to the gate 96 as retaining gate 96, *id.* at col. 3, ll. 64, but the terms "gate" and "retainer" are never interchanged nor is there any suggestion that the components are interchangeable. They are separately defined, *id.* at col. 3, ll. 59-68 & col. 4, ll. 1-15, separately claimed, *id.* at col. 10, ll. 10-15 & col. 11, ll. 12-14, and refer to distinctly separate elements in the '135 patent, *id.* at A00079 (the '135 patent at Fig. 2, showing separate components gate 96 and retainer 102).

As set forth in the petition at 11-16, when the term "gate" is properly interpreted, no reasonable jury could find such a component, either literally or under the doctrine of equivalents, in any accused Driltech device. When a trial court instructs a jury to use a "plain meaning" for a term that has a limited meaning in the patent, the court either relies on the jury to thoroughly review the patent and its prosecution history to ascertain the proper "plain meaning" interpretation to apply, or the court offers the jury the opportunity to interpret the term in a manner inconsistent with the patent and its prosecution history. Either way, this abrogates the court's responsibility to provide the jury with a claim interpretation. *Markman II*, 517 U.S. at 391. In the latter case, it also conflicts with *Markman II*'s requirement to interpret terms in a manner so as to comport with the patent as a whole. *Id.* at 389. This violation of the Court's precedent in *Markman II* is particularly noteworthy here, where Reedrill asserted a

meaning for a claim term that is inconsistent with the use of that term in the patent document itself.

II. This Court Has Granted Certiorari in Cases Involving Fed. Cir. R. 36 Judgments

Reedrill also argues that as this case was decided by the Federal Circuit under Fed. Cir. R. 36, the pending petition should not be granted. However, this Court has granted certiorari in cases where judgment was entered under Fed. Cir. R. 36. *See Wiggins v. Department of Interior*, 86 F.3d 1179 (Fed. Cir. 1996), *cert. granted*, *King v. Erickson*, 117 S. Ct. 2506 (1997). As in *Wiggins*, the petition for certiorari should be granted.

CONCLUSION

Claim interpretation is a question of law. It is the exclusive province of the court. Where a jury is instructed to use the "plain meaning" for a term that has a particular meaning in the patent, *Markman II* is violated. The violation is particularly noteworthy where, as here, a party asserts a claim interpretation that is inconsistent with

the patent itself. For the reasons set forth in the petition and this reply, the petition should be granted.

Respectfully submitted,

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